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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,280	11/12/2003	Patrick Guiney	11.037011 US	9311
41696 7590 04/14/2009 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070				
			EXAMINER	
			HYUN, PAUL SANG HWA	
			ART UNIT	PAPER NUMBER
			1797	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/712,280

**Applicant(s)**

GUINEY, PATRICK

**Examiner**

PAUL S. HYUN

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-6, 9-16, 18, 19, 21-23, 26-42 and 59-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 9-16, 18, 19, 21-23, 26-42 and 59-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/21/09.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed on January 21, 2009 has been acknowledged. Claims 1, 4-6, 9-16, 1819, 21-23, 26-42 and 59-69 are currently pending. Claims 1, 9, 10, 18, 26, 27 and 59 have been amended. Applicant amended claims 1 and 18 to incorporate the subject matter of previously pending claims 2 and 25, respectively. Applicant also further limited claim 59 by specifying that the claimed data storage device is positioned within the claimed data communications port.

The IDS filed by Applicant on January 21, 2009 has been acknowledged.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **1, 4-6, 9-12, 14-16, 18, 19, 21-23, 26-31, 33-37, 39-41, 43 and 59-69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. (US 2003/0098271 A1) in view of Nova et al. (US 6,136,274) and Marsh et al. (US 5,219,294).

Somack et al. disclose a sample tray 50 configured to be processed by a work station (see [0010]). The tray comprises an array of apertures wherein a cylindrical filter membrane 54 for immobilizing a sample (e.g. blood, tissue, microorganisms) is positioned in each aperture (see Fig. 7). The tray can comprise a bar code associated with each aperture for storing data related to the filter, such as the type of filter used to immobilize the sample and the test to be performed on the sample (see [0009] and [0060]). The tray disclosed by Somack et al. differs from the claimed invention in that

Somack et al. do not disclose a data storage device that is accessible via a recessed interface.

Nova et al. disclose a microplate comprising an integrated memory (see lines 29-44, col. 14). The memory device can be integrated into the microplate for storing data related to each well. The memory can be in the form of a bar code (see line 11, col. 22), a RAM (see line 64, col. 21) or a programmable ROM (see line 35, col. 20). Marsh et al. disclose a parallel port connector for interfacing two devices (e.g. computer and printer). The connector comprises a symmetrical recess comprising tapered surfaces 38a and 38b to ensure a solid physical connection (see Figs 1 and 6 and line 51, col. 3).

In light of the disclosure of Nova et al., it would have been obvious to one of ordinary skill in the art to provide the tray disclosed by Somack et al. with an electronic memory, such as a RAM or a ROM, instead of a bar code, so that information to and from the work station can be transferred by linking the tray to the work station. In light of the disclosure of Marsh et al., it would have been obvious to one of ordinary skill in the art to provide the modified Somack et al. tray with the serial connection disclosed by Marsh et al. so that the tray can be securely docked with a work station.

With respect to claims 14 and 15, Somack et al. do not explicitly disclose that the bar codes store information such as the number/parameters of processing steps involving the filter. However, the reference does disclose that the bar codes can store information directed towards the intended application of each sample and filter (see [0009]). In light of the disclosure, it would have been obvious to one of ordinary skill in

the art to store the procedural steps for accomplishing the intended application in each bar code so that the intended applications can be automated.

With respect to claims 16 and 69, although Somack et al. do not explicitly disclose that each bar code comprises a unique registration number, it would have been obvious to provide each bar code with a unique registration number so that the bar code reader can identify and distinguish the bar codes. The reference also appears to disclose that each bar code comprises a registration number. [0060] discloses that each bar code stores data corresponding to the location of each well. Thus, it appears that this data distinguishes the bar codes from one another. This data is within the scope of the limitation "unique registration number".

Claims **13 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. and Marsh et al. as applied to claims 1, 4-6, 9-12, 14-16, 18, 19, 21-23, 26-31, 33-37, 39-41, 43 and 59-69, and further in view of Crosby (US 6,770,487 B2).

None of the cited references disclose that the information stored in the bar code includes the expiration date of the filter medium.

Crosby discloses an absorbent medium for collecting a biological sample thereon. The absorbent medium further comprises a bar code wherein one of the information stored in the bar code is the expiration date of the absorbent medium (see lines 10-15, col. 4). Since the absorbent disclosed by Crosby is similar to a filter, it would have been obvious to one of ordinary skill in the art to store in the bar codes the

expiration date of each filter medium disclosed by Somack et al. to ensure proper preservation of the samples.

Claims **38 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Somack et al. in view of Nova et al. and Marsh et al. as applied to claims 1, 4-6, 9-12, 14-16, 18, 19, 21-23, 26-31, 33-37, 39-41, 43 and 59-69, and further in view of McDevitt et al. (US 2002/0045272 A1).

None of the cited references disclose a wireless interface or an electro-optical interface.

McDevitt et al. disclose a sample container that is capable of interfacing with a testing apparatus. The container can communicate with the testing apparatus wirelessly or by means of infrared sensors (see [0558]). In light of the disclosure of McDevitt et al., it would have been obvious to one of ordinary skill in the art to interface the modified Somack et al. tray with the work station wirelessly or by means of infrared sensors.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but they are moot in view of the new grounds of rejection. However, since no new prior art was cited, some of Applicant's arguments remain pertinent. Thus, they will be addressed.

Applicant's arguments with respect to the Somack et al. reference have been fully considered but they are not persuasive.

Applicant argues that the disclosure of the Somack et al. directed towards bar codes has been mischaracterized. Specifically, Applicant argues that the bar coded

"devices" referred to in said disclosure are directed toward tubular capsules, not a tray. Therefore, Applicant argues that Somack et al. do not disclose a sample tray comprising a data storage device. This argument is not persuasive because the reference discloses multiple embodiments of a "device" wherein one embodiment of the device is a tray comprising integrated filters (see Fig. 7 and [0008]). Specifically, the passage discloses that the "reaction device is provided in the form of a plate system". Although the term "device" can refer to capsules, the term also refers to the tray illustrated in Figure 7. Therefore, the Examiner maintains the position that all disclosure by Somack et al. directed towards bar codes is applicable to the plate system 50 illustrated in Figure 7. Likewise, the Examiner maintains the position that [0010] of the reference describing automated processing is applicable to the plate system 50.

Applicant also argues that the rejection of claim 16 should be withdrawn because the bar codes disclosed by Somack et al. do not inherently have unique registration numbers. This argument is not persuasive. As indicated in the rejection above, the rejection was based on the premise that it would have been obvious to one of ordinary skill in the art to provide each bar code with a registration number so that the bar codes can be distinguished. The rejection does not allege that the bar codes inherently have registration numbers. Nonetheless, the reference does appear to disclose that each bar code comprises a registration number. [0060] discloses that each bar code stores data corresponding to the location of each well. Thus, it appears that this data distinguishes the bar codes from one another. This data is within the scope of the limitation "unique registration number". Any numerical system that can uniquely identify something is

within the scope of "unique registration number". For the foregoing reasons, Applicant's arguments with respect to the Somack et al. reference are not persuasive.

Applicant's argument with respect to the Crosby reference has been fully considered but it is not persuasive.

Applicant argues that while Crosby discloses a test strip for performing a diagnostic test wherein the test strip comprises a bar code for storing an "expiration date", it is unclear what the "expiration date" refers to. Therefore, Applicant argues there is no motivation to store the expiration date of a filter in the bar code disclosed by Somack et al. This argument is not persuasive. Despite the ambiguity, the disclosure of Crosby is sufficient to motivate one of ordinary skill in the art to incorporate the relevant expiration date into the bar code disclosed by Somack et al. Specifically, Crosby discloses that absorbents, which is very similar to a filter, comprises an expiration date. Thus, there is motivation within the disclosure of Crosby to store the expiration date of the filters disclosed by Somack et al. in the storage device. For the foregoing reason, Applicant's argument with respect to the Crosby reference is not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/  
Examiner, Art Unit 1797

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797